

REMARKS

Upon entry of the new claims, claims 1-9 and 16-22 will be pending. Claims 16-22 have been newly added. The new claims are supported in the specification as originally filed, including the originally filed claims, and, as such, no new matter has been added.

Regarding the Rejection under 35 U.S.C. §103

Claims 1-9 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Frey (U.S. 6,027,494) in combination with Largent (U.S. 6,312,424).

The combination of Frey and Largent is traversed for at least the reasons previously made of record. Frey discloses a system and method where the cornea is reshaped in an area approximately equal to the dark adapted pupil size of the eye in order to reduce halo effect and/or improve night vision. The disclosure of Frey, however, is limited to adjusting just one aspect of the ablation region in response to pupil size – i.e., the outer periphery or overall extent of the region of the cornea subject to ablation. Frey does not teach a multifocal ablation shape, and certainly fails to teach adjusting an ablation cut profile, e.g., for both a first region and second region, of a multifocal ablation shape in response to the size of the pupil, as specifically recited in claim 1 or 16.

Largent does not cure the deficiencies of Frey. Largent discloses a method of vision correction via shaping multiple regions of a cornea to provide vision correction at multiple corresponding distances. Largent does not teach adjusting any aspect of an ablation shape based on pupil size. Even if, for arguments sake only, one were to attempt to combine the references by employing the pupil size based adjustment of Frey with the multi-region corneal ablation of Largent, the combination would appear to be limited to adjusting only the overall size of the ablation region such that the outer periphery of the ablation region covers the maximum pupil size, as Frey's approach changes only the overall size of the treatment without any change in shape.

Thus, only one aspect of the ablation region (i.e., overall diameter of the ablation region) would be adjusted based on the pupil size of the hypothetical combination of Frey and Largent. The cited references, alone or in combination, would at least fail to teach or reasonably suggest "...adjusting an ablation cut profile of the multifocal ablation shape in response to the size of the pupil so as to provide a balance of the near vision correction provided by the first region and the far vision correction provided by the second region for the patient...", as recited in current claim 1.

With regard to newly added claim 16, the cited references would at least fail to teach or suggest "...adjusting an ablation cut profile for both the first region and the second region of the multifocal ablation shape in response to the size of the pupil so as to provide a balance of the near vision correction provided by the first region and the far vision correction provided by the second region for the patient..."

Newly added claim 17 will be allowable for at least a similar rationale. The cited references, alone or in combination, at least fail to teach or suggest "...determining the distribution of laser beam pulses to ablate the first and second regions of the multifocal ablation shape, where the distribution of laser beam pulses for ablating both the first and second regions are determined in response to a signal related to a size of the pupil so as to balance the near vision correction and the far vision correction of the multifocal treatment for the patient", as recited in claim 17. Dependent claims 2-9 and 18-22 will be allowable at least for depending from allowable independent claim 1 and 17, respectively, as well as on their own merits.

Regarding the Decisions by the Board of Appeals

As basis for reopening prosecution of the present case and applying the current rejection to claims 1-9, the Office action cites to Decision by the Board of Appeals rendered 5/21/2008 (hereafter, "Decision by the Board") and the Decision on Rehearing rendered 10/30/2008 (hereafter, "Decision on Rehearing"). Applicants respectfully disagree, however, that either of those decisions by the Board supports the current rejection of claims 1-9 as obvious in view of Frey and Largent as stated in the current Office action. If anything, those decisions by

the Board of Appeals appear to actually support the patentability of current claims 1-9 over the prior art to Frey and Largent. Newly added claims 16-22 will be allowable for a similar rationale.

By way of background, the cited references to Frey and Largent were addressed at length both during prosecution and before the Board on appeal. The Board affirmed the rejection of previous claims 10-15 (now canceled) under 35 U.S.C. 103(a) in view of Frey/Largent, but did not extend the same obviousness rejection to current claims 1-9. The Examiner's only rejection of claims 1-9, under 35 U.S.C. 112, first paragraph for alleged inadequate written description, was reversed pursuant to the Decision by the Board and the Decision on Rehearing, thereby placing claims 1-9 in condition for allowance. Rather than permitting claims 1-9 to proceed to allowance, the current Office action reopens prosecution and applies the previously addressed combination of Frey and Largent to current claims 1-9.

The rationale for reopening prosecution and applying the current obviousness rejection, as stated in the present Office action, was that the Board's affirmation of written description support for claims 1-9 "enlightened the examiner" as to the scope of subject matter of those claims, and, as a result of the Board's broad construction, those claims "are now open to an obviousness inquiry." (page 2, 4 of 11/12/09 Office action).

Applicants respectfully disagree with this rationale, since originally filed claims 1-9 have been open to obviousness inquiry throughout prosecution, and the scope of those claims is unaltered by the Board's decision. The Examiner's previous rejection of claims 1-9 under 35 U.S.C. §112, first paragraph challenged whether the (undisputed) scope of subject matter embraced by those claims found written description support in the specification as originally filed. In reversing that rejection, the Board affirmed the presence of such written description support, but raised no new issues with respect to claim construction or scope of subject matter embraced by those claims.

Additionally, the issue of obviousness now being re-visited is believed to have already been considered with respect to current claims 1-9. It is well established that a challenge to written description support does not preclude examination of claim patentability under other statutory provisions, including 35 U.S.C. §103. In fact, the USPTO's written description

guidelines explicitly instruct that, “[r]egardless of the outcome of [a written description determination], Office personnel must complete the patentability determination under all relevant statutory provisions of title 35 of the U.S. Code”, including 35 U.S.C. §103 (MPEP §2163(III), emphasis added). Thus, the originally filed claims 1-9 have been open to an obviousness inquiry throughout prosecution, and the Examiner presumably had already previously evaluated current claims 1-9 for obviousness in view of Frey and Largent since those references were considered by the Examiner at least since July 2005 (see, e.g., Office action mailed 7/25/2005).

Moreover, it is believed that the issue of potential obviousness of claims 1-9 in view of Frey and Largent has already been considered by the Board. Per MPEP§1213.02 and 37 CFR 41.50, and in further view of the written description guidelines discussed above, the Board has express authority during appeal to make a new rejection of any of the claims pending in the case at hand, including rejection on either the same or on different grounds from those applied by the Examiner. In the present case, the issue of obviousness over Frey/Largent of any of the pending claims, including current claims 1-9, was squarely before the Board both in forming the initial decision and during reconsideration. In both instances, the Board declined to reject claims 1-9 over Frey/Largent, even though the issue of obviousness in view of those references was being considered by the Board.

Applicants further submit that the Board’s affirming of the obviousness rejection of previous claim 10 over Frey/Largent does not necessarily support a corresponding rejection to the differently defined invention of claims 1-9, as alleged in the current Office action. The Board’s decision regarding obviousness in view of Frey/Largent was expressly specific to the language of claim 10¹, and the Board’s rationale for affirming rejection of previous claim 10 does not apply to current claim 1, which recites different language and, therefore, includes a differently defined scope of subject matter. As such, the Board’s conclusion of obviousness over

¹ See, e.g., Decision on Rehearing, page 3, addressing the scope and content of Frey/Largent “...in the manner recited in claim 10” and “vis-à-vis claim 10”; Decision on Rehearing, page 5, stating “...in can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements *in the way the claimed invention does...*” (original emphasis); Decision on Rehearing, page 5, stating “...whether there was an apparent reason to combine the known elements *in the fashion claimed...*” (original emphasis); Decision on Rehearing, page 6, addressing the invention subject matter “...in the manner recited in claim 10...”

Frey/Largent does not extend beyond the specific language of previous claim 10 in the manner suggested in the current Office action.

Moreover, neither the Decision by the Board nor the Decision on Rehearing contradicts Applicants position, as stated herein and previously made of record, regarding the failure of Frey and/or Largent to teach adjusting multiple regions of a multifocal ablation shape in response to size of a patient's pupil. For example, in the Request for Rehearing filed 7/21/2008 (see, e.g., pages 3-9, 13), Applicants noted that the proposed combination of Frey/Largent might at best direct a skilled artisan to adjust the outer periphery of a multi-region ablation shape of Largent and any accompanying change in ablation depth, but would not direct any adjustment to an inner ablation region. In affirming the rejection of claim 10, the Board reasoned simply that "[c]laim 10 does not recite 'adjusting the inner ablation regions'" (Decision on Rehearing, p. 7). Thus, the Decisions by the Board might indicate that claim 10 did not sufficiently recite those elements Applicants identified as missing from the prior art of Frey and Largent. The Board, however, did not dispute Applicants characterization of those references as failing to teach adjusting multiple regions of a multifocal ablation shape in response to size of a patient's pupil – a distinction more clearly recited in the currently pending claims.

Thus, for at least the reasons set forth above, the cited prior art fails to teach or reasonable suggest each and every element of the currently claimed invention, thereby precluding a case of *prima facie* obviousness. Neither the Decision by the Board nor the Decision on Rehearing supports the current rejection of claims 1-9 as obvious in view of Frey and Largent as stated in the current Office action. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1-9 under 35 U.S.C. 103(a).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

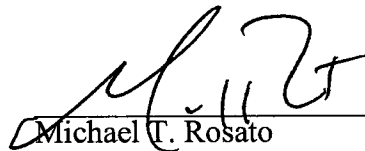
Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: _____

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